

REMARKS

I. General

Claims 1-8, 11-25 and 27-35 are presently pending in the application. No claims are amendeded by the present response. The issue in the current Office Action is as follows:

- Claims 1-8, 11-25 and 27-35 are rejected under 35 U.S.C. § 102(e) as being anticipated by US 2003/0229809 (hereinafter *Wexler*).

Applicant thanks the Examiner for the courtesy and professionalism shown thus far. Applicant hereby traverses the above rejections and requests reconsideration and withdrawal in light of the remarks contained herein.

II. Claim Rejection

A. Rejection under 35 U.S.C. § 102(e) (*Wexler*)

On pages 2-13 of the Office Action, claims 1-8, 11-25 and 27-35 are rejected under 35 U.S.C. § 102(e) as being anticipated by *Wexler*.¹ Applicant respectfully traverses the rejection.

To anticipate a claim under 35 U.S.C. § 102, a reference must teach every element of the claim. M.P.E.P. § 2131. Moreover, in order for an applied reference to be anticipatory under 35 U.S.C. § 102 with respect to a claim, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claim.” M.P.E.P. § 2131 (citing *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989)). As discussed further below, these requirements are not satisfied by the 35 U.S.C. § 102 rejection because *Wexler* does not teach every element of the claims.

For instance, claim 1 recites, in part, “said security device not itself having a network address or a physical address.” *Wexler* does not teach this feature of claim 1 at least because it does not appear to teach a security device not having a physical address. The Office Action

¹ The rejection states that claims 1-35 are rejected, but it is noted that claims 9, 10, and 26 have been canceled. Applicant does not present arguments for canceled claims and does not admit that any of the canceled claims are unpatentable.

cites *Wexler*'s proxy server 22 as teaching the claimed security device. Office Action at 2-3. However, *Wexler* teaches that its proxy server includes a MAC address, which is one type of physical address—"[i]f the requested address is included in the cache, transparency module 46 responds by transmitting (154) an ARP response which includes the MAC address of the port of proxy server 22 through which the request was received." *Wexler* at [0105] (emphasis added). Accordingly, *Wexler* fails to teach the above-recited feature of claim 1.

In response to Applicant's arguments, the Office Action cites paragraph [0048] of *Wexler*, which states, in part, "[o]ptionally, edge router 26 and/or external router 28 are not aware of the presence of proxy server 22 along path 24, in layer-2." Office Action at 3 and 8. The Office Action alleges that the above-quoted sentence of *Wexler* teaches that *Wexler*'s proxy server may not include a layer-2 address and, thus, *Wexler* teaches an embodiment not having a physical address. Applicant respectfully disagrees.

The above-quoted sentence from paragraph [0048] of *Wexler* does not teach that the proxy server 22 does not have a physical address. Rather, paragraph [0048] of *Wexler* teaches that routers 26 and 28 may not be aware of the presence of proxy server 22 in level-2. The rejection assumes that lack of awareness of a level-2 address by routers 26 and 28 necessarily means that proxy server 22 does not have a level-2 address, but the assumption is incorrect.

The context of the above-quoted sentence indicates that proxy server 22 of *Wexler* does, indeed, have a level-2 address, but that its level-2 address is not indicated in forwarded packets. In the two sentences preceding the above-quoted sentence, *Wexler* describes actions by the proxy server 22 to keep its level-3 presence unknown. *Wexler* explains that proxy server 22 forwards packets with the same IP addresses "as they are received," so that router 26 and router 28 are not aware of the presence of proxy server 22 in level-3. *Wexler* at [0048]. The sentence cited by the Office Action indicates an operation similar to the level-3 operation that keeps the level-2 presence of the proxy server 22 unknown by forwarding packets with the same addresses as are in the received packets.

In other words, *Wexler* does not teach that proxy server 22 does not have a level-2 address, but instead teaches that packets forwarded by proxy server 22 do not provide other

components with an indication of the level-2 address of proxy server 22. Applicant's explanation of paragraph [0048] is consistent with other teachings in *Wexler*, whereas the Office Action's interpretation of paragraph [0048] is contradicted by other teachings in *Wexler*. For instance, *Wexler* at paragraph [0105] explicitly says that proxy server 22 has a MAC address. Accordingly, it is clear that *Wexler* does not teach "said security device not itself having a network address or a physical address," as recited by claim 1.

Claim 8 recites, in part, "said security device is connected to said network without establishing a network address or a physical address for said security device." Claims 1 and 8 have differing scopes. Nevertheless, it is believed that the above-recited feature of claim 8 is not taught by *Wexler* at least for the reasons expressed above with respect to claim 1.

Claim 17 recites, in part, "inserting a security device into said network while said network is operating." The rejection of claim 26 (now canceled) indicates that this feature is disclosed in paragraph [0009] of *Wexler*. Office Action at 10 and 13. The cited section of *Wexler* discloses, in part, "[u]sing a transparent proxy server eliminates the need to configure the network elements with the identity of the proxy server." However, the cited section of *Wexler* does not disclose inserting the security device into the network while the network is operating. The Office Action appears to assert that one of ordinary skill in the art would understand from the above-recited portion of *Wexler* that the system of *Wexler* is capable of being inserted without temporarily deactivating the network. *Id.* at 13. Without admitting that the Office Action's assertions are true, it is noted that the cited portion of *Wexler* does not actually teach inserting its proxy server into the network at any particular time. In order for an applied reference to be anticipatory under 35 U.S.C. § 102 with respect to a claim, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." M.P.E.P. § 2131, citing *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913 (Fed. Cir. 1989). The cited passage of *Wexler* does not provide the requisite level of detail to be anticipatory.

In the response to arguments section of the Office Action, the Office Action asserts that one of ordinary skill in the art would understand that "configuration causes network to be temporarily deactivated and by providing a transparent proxy server that eliminates

configuration need, network can continue to function without interruption.” Office Action at 13. Without admitting that the Office Action’s assertions are correct, it is noted that claim 17 recites an action being performed, but by contrast, the Office Action merely asserts that *Wexler* teaches that an action can be performed. Furthermore, there is no indication that inserting a security device into the network while the network is operating is inherently performed during the normal and usual operation of the *Wexler* device. *See* M.P.E.P. § 2112.02. Therefore, it is respectfully submitted that *Wexler* does not teach this feature of claim 17.

Claim 28 recites, in part, “said security device not including a physical address.” Claims 1 and 28 have differing scopes. Nevertheless, it is believed that the above-recited feature of claim 28 is not taught by *Wexler* at least for the reasons expressed above with respect to claim 1.

Claim 31 recites, in part, “inserting said security device while said data network is operating.” Claims 31 and 17 have differing scopes. Nevertheless, it is believed that the above-recited feature of claim 31 is not taught by *Wexler* at least for the reasons expressed above with respect to claim 17.

Dependent claims 2-7, 11-16, 18-25, 27, 29, 30, and 32-35 each depend either directly or indirectly from respective independent claims 1, 8, 17, 28, and 31 and, thus, inherit all of the limitations of their respective independent claims. Thus, *Wexler* does not teach all claim limitations of claims 2-7, 11-16, 18-25, 27, 29, 30, and 32-35. It is respectfully submitted that dependent claims 2-7, 11-16, 18-25, 27, 29, 30, and 32-35 are allowable at least because of their dependence from their respective base claims for the reasons discussed above. Accordingly, Applicant respectfully requests the withdrawal of the 35 U.S.C. § 102 rejection of claims 1-8, 11-25 and 27-35.

III. Conclusion

In view of the above, Applicant believes the pending application is in condition for allowance.

Applicant believes no fee is due with this response. Please charge any additional fees required or credit any overpayment to Deposit Account No. 06-2380, under Order No. 58895/P004US/10306553 during the pendency of this Application pursuant to 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees.

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Respectfully submitted,

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